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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re EmployAbility, Inc.

Serial No. 76311058

James F. Kamp, Mary Margaret L. O'Donnell and Michelle L. Visser of Rader, Fishman & Grauer for EmployAbility, Inc.

Michael Keating, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Walters and Bottorff, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

EmployAbility, Inc. has filed an application to register on the Principal Register the mark EMPLOYABILITY for "employment services, namely, employment hiring, recruiting, placement, staffing and career networking

services, employment counseling, all for the disabled population,"¹ in International Class 35.

The Trademark Examining Attorney has issued a final refusal to register, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive in connection with its services.²

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs and an oral hearing was held. We affirm the refusal to register.

Applicant contends that the mark is a double entendre, which "hinges on the specific nature of applicant's services as applied to disabled individuals" (Brief, p. 7); that its mark is a combination of the terms "employ" and "ability"; that the merger in the mark of the two separate words into a single word does not detract from the significance of the individual words; that the mark "removes the negative 'dis' prefix from 'disabled,' focusing on the positive portion of 'abled,' 'able' or 'ability'" (*id.*); and "thus, the mark suggests how the disabled may use their abilities to

¹ Serial No. 76311058, filed September 6, 2001, based on an allegation of a bona fide intention to use the mark in commerce.

² In his brief, the Examining Attorney correctly states that applicant's alternative request for registration on the Supplemental Register is improper because the application is based upon an allegation of a bona fide intention to use the mark in commerce and no amendment to allege use has been filed. This issue has been given no consideration by the Board.

participate in a working environment." (*Id.*) Applicant also argues the following (*id.*, p. 8):

[The mark] also plays on the term "employ," which generally means "hire" or engage," but also can mean "use" or "take advantage of." With this in mind, the term EMPLOYABILITY as applied to the disabled population has both the double entendre of the term "ability" as opposed to "disability" **and** the double entendre of the term "employ" in the sense of "use" or "take advantage of" as opposed to "hire" or "engage." Put together, and viewed in relation to the *identified services*, the mark both highlights the positive aspect of **ability** in general as applied to the disabled population and also the broader goal of encouraging the disabled to **use** or **take advantage** of their **abilities** for a work-related purpose. (*Emphasis in original.*)

Regarding the Lexis/Nexis evidence and Internet research submitted by the Examining Attorney and discussed below, applicant states the following (*id.*, p. 11):

Thus, at best, the Examining Attorney's evidence shows that "employability" may have some descriptive qualities with respect to employment counseling or counseling in general. Although such evidence may be competent to show that the term "employability" exists in the English language and that it may even be descriptive of employment counseling in general, the Examining Attorney must still perform the mere descriptiveness evaluation in light of the specific goods or services recited in the application ...

Applicant asks the Board to resolve any doubt in its favor.

The Examining Attorney contends that the "plain meaning" of the mark is merely descriptive in connection with applicant's identified services, even as restricted to the disabled population, because its services "involve

determining the employability of individuals using its employment services [and that] applicant will recruit and evaluate individuals with an eye toward placing them in appropriate positions, consulting with them in the course of placement, and working with them to find them jobs."

(Brief, unnumbered pp. 4-5.) The Examining Attorney argues that applicant's double entendre argument may reflect applicant's reason for choosing its mark, but that it is the plain meaning, *i.e.*, the dictionary definition, of EMPLOYABILITY that is likely to be perceived by purchasers; that the mark is not likely to be perceived as two words, "employ" and "ability" because of the fact that the merged term, "employability," is a separate word; and that the mark is merely descriptive regardless of whether the mark is viewed at two merged words or one word.

The Examining Attorney submitted a definition from *Webster's Third New International Dictionary of the English Language*, 1993, of "employability" as "n. the quality or state of being employable." We also note the entry following "employability" in the same dictionary - "employable," which is defined as "adj. capable of being employed; *specif.* physically and mentally capable of earning a wage at a regular job and available for hiring."

The Examining Attorney submitted excerpts of articles retrieved from the Lexis/Nexis database, of which several examples follow:

"Through a contract with Job Training Centers of Fort Pierce, the agency provides services under the Job Training Partnership Act. Those services include assessment, career counseling and planning, occupational skills training, employability skills training, job placement, on-the-job training, internships and re-employment assistance for displaced workers." [*The Stuart News/Port St. Lucie News*, November 8, 1999.]

"Friendship's Apprenticeship and Job Resources Center offers vocational counseling, employability skills training, job placement and post-placement assistance to adult D.C. residents." [*Roll Call*, November 19, 1998.]

"Free GED and high school diploma classes are being offered by the West Area Adult and Community School and local extension sites. Supplemental career counseling and employability skills will be provided at the school." [*The Ledger*, August 4, 1997.]

"Caseloads have decreased significantly since the statewide expansion and the federal government's approval of Utah's reform plan. In July 1996, there were 14,335 participants, most working on employment plans defined broadly enough to include education and/or counseling to increase a client's stability and employability, Bishop said." [*The Salt Lake Tribune*, July 1, 1997.]

The programs provide services to aid dislocated workers, the economically disadvantaged and welfare recipients. Cattanach said several of them offer the same type of services. For example, services such as career counseling, employability assessment and post-placement follow-up are offered by at least one-third of the programs, Cattanach said." [*Capital Times*, November 15, 1994.]

"The program, based in high schools, seeks out students who have no plans beyond graduation and

enrolls them in a counseling program. Helping assess their own employability, the course also urges the importance of such basics as good grooming, self-confidence, speaking well, and being on time." [*The Christian Science Monitor*, June 25, 1981.]

The Examining Attorney also conducted a search for the phrase "employability counseling" using the Google search engine (www.googl.com). The partial results, submitted herein, show uses of the term "employability" consistent with the excerpts shown above.

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the

average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

We agree with the Examining Attorney that EMPLOYABILITY is merely descriptive in connection with applicant's "employment services, namely, employment hiring, recruiting, placement, staffing and career networking services, employment counseling, all for the disabled population." The record clearly establishes that "employability" is a word in the English language that is commonly used in the employment field, and that employability assessments and counseling are particular to populations that may have difficulties, or specific issues regarding, obtaining and maintaining employment. Further, for populations who have employability issues, such as the disabled, employability evaluation and counseling is likely to be encompassed within the identified services of "employment counseling."

We appreciate the possible double entendre meanings of its mark that applicant posits, *i.e.*, that "ability" is used as and would be understood to be an empowering term as applied to persons with disabilities, and that "employ" means "use" or "take advantage of" as well as "hire." However, we find that these suggested double entendres simply are too subtle and tenuous to be readily perceived and understood by relevant purchasers who encounter the mark in connection with applicant's services. *See, e.g., In re*

Wells Fargo & Co., 231 USPQ 95 (TTAB 1986) (EXPRESSSERVICE merely descriptive of banking services; alleged "Pony Express" double entendre would not be readily recognized). Applicant's argument to the contrary, i.e., that the relevant purchasers (including or especially disabled persons) would be familiar with and/or readily recognize these double entendres, is not supported by any evidence in the record. Given the direct relevance of the dictionary meaning of "employability" to the recited services, the Examining Attorney's evidence that the word is commonly used in precisely that dictionary sense in connection with such services, and the absence of evidence that the relevant purchasers are familiar with or would readily recognize the double entendre meanings suggested by applicant, we find that it is the dictionary meaning of the word "employability," and that meaning alone, that purchasers will immediately and directly perceive when they view applicant's mark in connection with applicant's services. Moreover, it is clear from the evidence of record that others in the employment counseling field use, and have a competitive need to use, the term "employability" descriptively in connection with their services.

In conclusion, when applied to applicant's services, the term EMPLOYABILITY immediately describes, without conjecture or speculation, a significant feature or function

of applicant's services, namely, that the disabled population served by applicant's various employment services and counseling is employable. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's services to readily perceive the merely descriptive significance of the term EMPLOYABILITY as it pertains to applicant's services.

Decision: The refusal under Section 2(e)(1) of the Act is affirmed.

Seeherman, Administrative Trademark Judge, dissenting:

I respectfully dissent.

As has been discussed by the majority, the word EMPLOYABILITY does have a descriptive significance. However, I believe that the mark is still registrable for the identified services because it is not merely, in the sense of only, descriptive. In addition to the descriptive meaning, it has a double entendre based on the individual words EMPLOY and ABILITY which make up the mark.

This double entendre stems from the concept of the "ability" that those with disabilities have. There is a great emphasis today on the abilities, rather than the disabilities, of people with handicaps, and there is a great sensitivity about any negative reflections on those with disabilities. Terms like "differently abled" are used

instead of "disabled" to indicate that people with disabilities are able to function and, in the case of employment services, use their particular abilities to engage in employment activities.

As the majority points out, the determination of mere descriptiveness must be made in relation to the impact a mark is likely to have on the average purchaser of the particular goods or services. Applicant's services are identified as "employment hiring, recruiting, placement, staffing and career networking services, employment counseling, all for the disabled population." The users or purchasers of such services, thus, are those who are disabled, or those who deal closely with or hire the disabled. Such people will be particularly sensitive to the concept of "ability" as a substitute for "disability" in this population, and will readily perceive the double entendre in EMPLOYABILITY that the words in applicant's mark EMPLOYABILITY convey, i.e., that employers should hire (employ) people because of their abilities, rather than view their disabilities as a deterrent to hiring.³ Thus, the mark does not convey to purchasers and users of applicant's services *only* its descriptive meaning. See *In re Colonial Stores Incorporated*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968)

³ Applicant also suggests an additional meaning for the term, that people should use (employ) their abilities in a working environment.

(SUGAR & SPICE found not merely descriptive of bakery goods); Blisscraft of Hollywood v. United Plastics Co., 294 F.2d 694, 131 USPQ 55 (2d Cir. 1961) (POLY PITCHER not merely descriptive of polyethelene pitchers).

The case of In re Wells Fargo & Co., supra, cited by the majority, is readily distinguishable. In that case, there was no double entendre in the EXPRESSSERVICE mark itself. Rather, consumers would have had to know and make a connection between applicant's name, Wells Fargo (with its predecessor's history involving the Pony Express), and the word EXPRESS in the mark. In the present case, the double entendre is created by the words EMPLOY and ABILITY which form the mark.

It is well established that doubt on the issue of mere descriptiveness must be resolved in favor of the applicant. See, for example, In re Gracious Lady Service, Inc., 175 USPQ 380 (TTAB 1972). I believe that the double meaning of EMPLOY ABILITY in the mark EMPLOYABILITY at the very least raises doubt as to whether the mark is *only* descriptive, and therefore it is my view that the application should be published for opposition.